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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,135	09/29/2003	Erik Monsen	F-709	2500

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11/08/2006

Pitney Bowes Inc.
Intellectual Property and Technology Law Dept.
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Shelton, CT 06484

EXAMINER

LIU, ERIC

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,135

Applicant(s)

MONSEN ET AL.

Examiner

Eric Liou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9-29-03, 5-17-05 and 9-28-06</u> | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 9/29/03, 5/17/05, and 9/28/06 was considered by the Examiner.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 45 (Figure 1C), 48 (Figure 1B), 58 (Figure 1C), 134 (Figure 2), and 152 (Figure 3). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 40 (paragraph 19 line 7), 49 (paragraph 7 line 7), 55 (paragraph 18 line 5), 88 (paragraph 18 line 6). Corrected

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drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because the reference number 18 described (specification - paragraph 17 line 7) does not match the reference number 18 in Figure 1B. Reference number 18 is defined to be a meter number in the specification. Reference number 18 in Figure 1B is defined to be the recipient address. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not

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accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 1 is objected to because of the following informalities: spelling error and lack of antecedent basis. The term countries in line 6 should be the singular form country to match the claim format (“country” in line 4). In addition, the definite article before “payment” and “carrier” should be changed to the indefinite article to provide proper antecedent basis (line 3). Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

8. Claims 1-7 do not provide a practical application that produces a useful result. For an invention to be “useful” it must satisfy the utility requirement of section 101. The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP § 2107.

9. Claim 1 recites a method for paying for mail comprising the steps of affixing a first indicia and affixing a second indicia. However, the body of the claim does not actively provide an executed step of payment. Furthermore, merely affixing a plurality of indicia does not move

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to manifest a useful result. The preamble of claim 1 purports utility, but the body of the claim is not commensurate with the scope of the preamble, and does not provide the “active steps” necessary to achieve the purported utility.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention. Specifically, since the elements of claim 1 are not supported by either an asserted utility or a well established utility for the reasons set forth above, one skilled in the art is not enabled to use the claimed invention.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce et al., U.S. Patent No. 6,865,558 in view of Kadaba U.S. Publication No. 2004/0215480.

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14. As per claim 1, Pierce teaches affixing a first indicia (Pierce: Fig. 4a, “30”) to mail for the payment of carrier fees for a first country (Pierce: column 4, lines 42-51); and affixing a second indicia (Pierce: Fig. 4a, “70a”) to the mail (Pierce: column 4, lines 42-51). It is important to note that there is a cost associated with the first indicia and the second indicia. In the case of the first indicia, the cost printed is the payment of carrier fees for sending mail in the first country. In the case of the second indicia, the cost printed represents a donation of \$0.10 that has been made by a user to the American Cancer Society (Pierce: column 4, lines 48-50).

15. Pierce does not teach that the second indicia affixed to the mail is for the payment of carrier fees for a second country.

16. Kadaba teaches the payment of carrier fees for a second country (Kadaba: paragraph 58, lines 6-10). Kadaba teaches an embodiment where a label containing indicia includes a second carrier address field that indicates the destination to which a first carrier is to deliver a package (Kadaba: paragraph 58, lines 6-10). Kadaba further teaches that package level details on the label is for payment purposes (Kadaba: paragraph 51 lines 3-6, Figure 3, paragraph 59 lines 9-12). According to these teachings, the United Parcel Service is considered the second carrier. The Examiner notes, the United Parcel Service is widely known as an international carrier, i.e. carrier for a second country. In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

17. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Pierce to have included a second indicia

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affixed to the mail for the payment of carrier fees for a second country as taught by Kadaba because a mail piece sent by multiple carriers allows each carrier to take advantage of their own respective strengths (Kadaba paragraph 10 lines 3-7). The end result of these combined teachings is an improved cost-effective system for delivering packages (Kadaba paragraph 10 lines 1-2).

18. As per claim 2, Pierce and Kadaba teach the method of claim 1 as described above. Pierce further teaches the first indicia is a post office postal indicia (Pierce: Figure 4a, "30", column 4 lines 46-47).

19. As per claim 3, Pierce and Kadaba teach the method of claim 1 as described above. Pierce further teaches the second indicia is a post office postal indicia (Pierce: Figure 4a, "30", column 4 lines 46-47). Since the specification does not describe the order in which the two indicia (postal indicia and American Cancer Society indicia) are printed on the mail piece, the Examiner is taking Pierce's teachings to include the case where the postal indicia is the second indicia.

20. As per claim 4, Pierce and Kadaba teach the method of claim 1 as described above. Pierce further teaches that the first indicia is a common carrier indicia (Pierce: Figure 4a, "30"). Webster's II New Riverside University Dictionary defines a common carrier to be one who transports passengers or goods for a fee. Pierce teaches a postal indicia that displays a fee required to transport a mail piece (Pierce: Figure 4a, "30"). One of ordinary skill in the art would recognize that this postal indicia is equivalent to a common carrier indicia.

21. As per claim 5, Pierce and Kadaba teach the method of claim 1 as described above. Pierce further teaches the second indicia is a common carrier indicia (Pierce: Figure 4a, "30").

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Since the specification does not describe the order in which the two indicia are printed on the mail piece, the Examiner is taking Pierce's teachings to include the case where the common carrier indicia is the second indicia.

22. As per claim 6, Pierce and Kadaba teach the method of claim 1 as described above. Pierce further teaches that the first and second indicia are affixed to mail by a postage meter (Pierce: column 3 lines 40-46). Pierce teaches a postage meter (Pitney Bowes DM300) in the mail processing system (Pierce: column 3 lines 40-46).

23. As per claim 7, Pierce and Kadaba teach the method of claim 1 as described above. Pierce further teaches that the first and second indicia are affixed to mail by a personal computer meter (Pierce: column 3 lines 34-37). Pierce teaches a postage metering system that includes a personal computer (Pierce: column 3 lines 34-37).

Conclusion

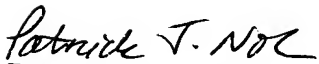
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Thursday, 7:30-5:00, Friday 7:30-4:00 (first Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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10/23/06